

REMARKS/ARGUMENTS

Preliminarily, Applicant notes that:

(a) it is unclear whether claim 2 has been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 6,462,001 ("Kenbeek '001"). Specifically, the rejection cited in paragraph 8 of the present Official Action (see page 6) does not list claim 2, although the ensuing arguments asserted by the Examiner present a section entitled "Regarding Claims 1, 2, and 16". In addition, there is no separate section detailing reasons for rejecting claim 3, 4, 7, or 9. Therefore, it should be noted that the Applicant's arguments provided below are presented under the presumption that claim 2, in addition to claims 3-4, 7, and 9, have been rejected under 35 U.S.C. §102(b) as being anticipated by Kenbeek '001; and

(b) claim 17 stands unrejected (it is, therefore, presumed to be in condition for allowance).

Reconsideration and allowance of the present application based on the following remarks are respectfully requested. Claims 2-7, 9-11, and 15-17 have been amended. Claims 1, 8, and 12-14 have been cancelled. New claims 18-21 have been added. Support for these amendments may be found throughout the specification. No new matter has been added as a consequence of these amendments.

Claims 1, 3-4, 6-7, 9 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by EP 0335013 ("Kenbeek") as evidenced by GB 1390439 ("Marchand"). Claim 5 stands rejected under 35 U.S.C. §102(b) as being anticipated by Kenbeek as applied to claim 1 in view of Marchand. Claims 1, 3-4, 7, 9 and 16 stand rejected under 35 U.S.C. §102(b) as being anticipated by Kenbeek '001. Claims 10-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek as applied to claims 1 and 9, and further in view of U.S. Patent 4,479,883 ("Shaub"). Claims 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek as applied to claim 1, and further in view of U.S. Patent 4,459,223 ("Shaub '223"). Claim 2 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kenbeek as applied to claim 1, and further in view of Kenbeek '001. Claim 8 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Kenbeek as applied to claim 1, and further in view of U.S. Patent 3,202,701 ("Young"). Finally, claims 12-14 stand rejected under 35 U.S.C. §112, second paragraph.

Applicant submits all rejections of claims 1 and 3-14 are now rendered moot in view of the amended claims, either by the cancellation of the immediate claim (i.e., claims 1 and 12-14), or as the result of amending the dependency of claims 3-11 on to claim 2. Accordingly, Applicant will address the rejections asserted to pending claims 2 (and its new dependencies) and 15-16.

The claims as pending are directed to engine oils, antiwear additive systems and/or methods of using the same comprising an ester formed *inter alia* from either (i) a dimer fatty acid comprising greater than 94 wt.% dimer, or (ii) at least one dicarboxylic acid as component (c). None of the cited references teach or suggest forming an ester from the components specified in the present claims -- much less an ester that achieves the properties as claimed.

Applicant further notes that a key feature that is highlighted throughout Kenbeek '001 is the choice of the polyfunctional carboxylic acid is such that no more than 80% dimer acid is present, which teaches away from the dimer fatty acid of the pending claims, as amended. Specifically, Kenbeek '001 discusses that compositions comprising amounts of dimerized acid greater than 80% by weight can be disadvantageous in terms of interactions with sulphur and/or phosphorous containing additives (See, col. 2, lines 27-34 of Kenbeek '001) and diminished oxidation performance (See, col. 3, lines 50-54 of Kenbeek '001).

Accordingly, all objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition for allowance and a Notice to that effect is earnestly solicited.

Should any issues remain unresolved, the Examiner is encouraged to contact the undersigned attorney for Applicants at the telephone number indicated below in order to expeditiously resolve any remaining issues.

Respectfully submitted,

JONES DAY

By:  Reg. No. 51,873
for Paul L. Sharer
Registration No. 36,004
Direct No. (202) 879-5481

Intellectual Property Group
51 Louisiana Avenue, N.W.
Washington, D.C. 20001-2113
(202) 879-3939 Telephone
(202) 626-1700 Facsimile

Date: June 3, 2009

WAI-2923866v4